IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of
Barbara A. Rincavage et al. Group Art Unit: 3623

Application No. 10086253 Examiner: RINES, Robert D.

Filed: 01MAR2002

For: SYSTEM AND METHOD FOR PREVENTING FRAUD AND MISTAKE IN THE ISSUANCE, FILLING AND PAYMENT OF MEDICAL PRESCRIPTIONS

PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR

Mail Stop Petition
Commissioner for Patents
P.O. Box 1430
Alexandria, Virginia 22313

Attn: Deputy Commissioner for Patent Examination Policy

Sir:

Petitioner hereby petitions to invoke the supervisory authority of the Director under 35 C.F.R. 1.181 to direct the Supervisory Patent Examiner to withdraw the final office action dated April 27, 2010 (copy attached) in this case for the following reasons:

1. This Petition is to invoke the Director's Supervisory Authority under 37 CFR 1.181 to withdraw the April 27, 2010 Final Rejection in this case for the following reasons:

2. A September 2, 2009 Board of Appeals decision in this case, upheld a final rejection rejecting claims 1 to 6, 8 to 9, and 12 to18 of this application under 35 U.S.C. §103(a) over Denny 20040107117 ("Denny") and Borsand et al. 20030074225 ("Borsand") and claims 10 to 11 and 19 to 20 under 35 U.S.C. §103(a) over Denny, Borsand and Keresman III, et al. ("Keresman").

3. Applicants filed an October 30, 2009 Amendment after Final with RCE.

4. October 30, 2009 Amendment pointed out that the October 30, 2009 Amendment after Final canceled all claims and substituted claims 21 to 30 to a "prescription fulfillment method" and claims 31 to 40 to a "prescription fulfillment system." The October 30, 2009 Amendment method claims recite "entering [a] filled and different medication brand or dosage into the processing center in fulfillment of [a] prescribed prescription" (hereinafter the "brand and dosage discretion" method). Further the amendment added system claims to a processing center that "accepts filled prescription information through the network from the pharmacist in fulfillment of the prescribed information but that differs in at least one respect from medication brand or dosage of the prescribed prescription information" (hereinafter the "brand and dosage discretion" system).

5. The October 30 Amendment pointed out that:

> The new claims claim an aspect of the invention relating to a system and method that admits of a pharmacist's discretion in filling a prescription. Prior art methods and systems (Denny, Keresman and Borsand[1]) allow a pharmacist to enter a "yes" signal for a filled description that confirms filling of a prescription issued by a physician or medical provider. However, there are instances where a pharmacist should properly exercise discretion in filling the brand or dosage of the prescription. For example in instances, a pharmacist may fill a prescription with a generic rather than a prescribed name brand or with a dosage that is equivalent but different from prescribed dosage, e.g. 20 pills at half strength for 10 prescribed pills at full strength). However, prior art "yes" methods and systems do not provide for entering a filled description that is different with respect to brand or dosage.

Page 6 of October 30 Amendment after Final Rejection (hereinafter referred to as the "brand and dosage discretion" argument).

6. The October Amendment canceled all claims and substituted the presently pending claims 21 to 30 to a "prescription fulfillment method" and claims 31 to 40 to a "prescription fulfillment system."

7. On December 16, 2009, the Patent Office issued an office action rejecting

1 To whatever extent that Borsand can properly be considered prior art.

claims 21 to 22, 27 to 30, 31 to 32 and 17 to 40 under 35U.S.C. §103(a) over Denny and Borsand and claims 23 to 26 and 33 to 36 under 35 U.S.C. 103 (a) over Denny, Borsand and Keresman.

8. 37 CFR 1.104 entitled "Nature of examination," states "(b) *Completeness of examiner's action*. The examiner's action will be complete as to all matters...." The December 16 2009 improperly failed to address (1) the important "brand and dosage discretion" method and system claim limitations and (2) the important "brand and dosage discretion" method and system arguments.

9. On January 6, 2010, Applicants' representative called the Examiner in this case and left a detailed message pointing out that the December 16, 2009 office action did not respond to Applicants' "brand and dosage discretion" claim limitations or respond to Applicants' "brand and dosage discretion" argument

10. Not having a response from the Examiner, on January 7, 2010, Applicants' representative again called the Examiner and left a message.

11. On January 13, 2010, Applicants' representative filed an Amendment that pointed out that the Patent Office had failed to address the new "brand and dosage discretion" claim limitations and arguments:

> To make out a *prima facie* case of obviousness, the PTO must show in the references (by column and line) the teaching that purportedly renders the invention obvious. *See In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed.Cir. 1993). If the PTO cannot point to express statements or implied suggestions of the claimed method or system invention in Borsand, then the rejections must be withdrawn. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).
>
> At page 7, the office action states:
>
> However, as is evidenced by Borsand et al., it is well known in the prescription fulfillment art for the pharmacist to record or enter into a database, information regarding

> the specifics of a filled prescription including cost, drug type, and quantity administered to the patient. Accordingly, Borsand et al. teach a method wherein said filled prescription data includes information for said presented pharmaceutical type and said presented quantity and "wherein the filled prescription is different from the retrieved prescription in respect of at least one or medical brand and dosage..." (Borsand et al.; paragraphs [0005] [0040] [0056] [0064] [0086] [0118] *see electronic representation of filled prescription).
>
> Applicants have searched Borsand for the quoted text material. It does not appear. Applicant has reviewed Borsand paragraphs [0005], [0040], [0056], [0064], [0086] and [0118] for any teaching or suggestion of "entering [a] filled and different medication brand or dosage into the processing center in fulfillment of [a] prescribed prescription..." (method recitation). No such teaching or suggestion appears. If the Patent Office disagrees, it must point out by column and line exactly where the relied upon disclosure appears or withdraw the rejections.

12. On April 27, 2010, the Patent Office issued a final rejection. The final rejection fails to address or mention Applicants' "brand and dosage discretion" claim limitations and arguments.

13. 37 CFR 1.104 entitled "Nature of examination," states "(b) *Completeness of examiner's action*. The examiner's action will be complete as to all matters...."

14. The Final Rejection fails to point out where any teachings relevant to "brand and dosage discretion" claim limitations appear in the references. See *In re Rijckaert*, 28 USPQ2d 1955, (Fed.Cir. 1993).

15. The final rejection must be withdrawn as required by 37 CFR 1.104 and law.[2]

2 ." "[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference...." *In re Rijckaert*, 28 USPQ2d *supra* at page 1957.

16. The Final Rejection is incomplete in failing to respond to Applicants' "brand and dosage discretion" claim limitations and arguments.

17. Further, MPEP 2271 states:

> In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed and any grounds or rejection relied on should be reiterated. The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal.... [T]he final rejection... *should include a rebuttal of any arguments raised in the patent owner's response*. (Emphasis added.).

18. Further, MPEP 707.07, entitled "Completeness and Clarity of Examiner's Action," provides that "[t]he examiner must address "all arguments which have not already been responded to in the statement of the rejection."

19. Further MPEP 707.07(f) entitled "Answer All Material Traversed" states "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

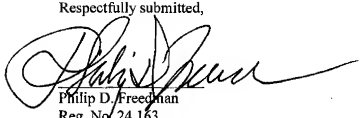
20. The Final Rejection is incomplete in failing to respond to Applicants' "brand and dosage discretion" claim limitations and arguments as required by the MPEP.

21. The final rejection should be withdrawn.

22. No fee should be required with this Petition since it is required by PTO error. However, please credit or debit Deposit Account No. 500917 in the amount of the fee and further as needed for any additional fee to ensure consideration of this Petition.

WHEREFOR, Petitioner respectfully requests the Director under 35 C.F.R. 1.181 to exercise supervisory review authority to direct the Supervisory Patent Examiner to withdraw the March 19, 2010 final rejection in the above matter without delay.

Respectfully submitted,



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MAY, 2010